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EXAMINER

KUMAR, UTTAM

ART UNIT	PAPER NUMBER
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2157

DATE MAILED: 12/18/2003

3

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/682,489

Applicant(s)

LAMMING ET AL.

Examiner

Uttam Kumar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) ____ is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). ____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1 . 6) ☐ Other: .

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims **1, 23 and 24** are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The phrase "directed at an output device" implies that the document request is being made to the output device, wherein it is understood from the request of the claim that the document request is actually being made to a document server.

2. Claim **1, 23 and 24** are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential elements, such omission amounting to a gap between the elements. See MPEP § 2172.01. The omitted elements are: There is a first communication channel between the mobile device and the output device and a second communication channel between the mobile device and the document server. It is unclear how the document server communicates with the output device.

3. Claim **18** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear how and from where the output device profile is attained. If the mobile computing device automatically detects the profile, then what differentiates this claim from claim 17?

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4. Claim **19** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The term "inadequate" is indefinite.

5. Claim **22** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 22 claims that the parameters, the name of the document and the output device type, are specified using a name of the document. The meaning of "specified using a name of the document" is unclear.

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

The specification is objected to under 35 U.S.C 112, first paragraph, as failing to adequately teach how to make and/or use the invention. The specification is enabling for a portion of the subject matter claimed but the enablement is not commensurate in scope with the claim. Specifically, the specification fails to show how the single step of "recording..." of claim 9 can perform the claimed functions. Thus, it would require undue experimentation for a person having ordinary skill in the pertinent art to make and use the invention as disclosed and claimed.

Claim **9** is rejected under 35 U.S.C. 112, first paragraph, for the reasons set forth in the objection the specification. Single means claim 9 is

subject to an undue breadth rejection. See *In re Hyatt* 218 USPQ 195 (CAFC 1983).

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. The claimed language/step of "recording..." is not entirely clear for the reasons mentioned above.

Claim Rejections - 35 USC § 102

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1, 3, 7, 8, 10, 12, 16, 17, 20, 21 and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Parulski et al (U.S. 5,666,159).

12. As to claim 1 and 23 Parulski et al discloses an electronic camera system with programmable transmission capability teaches:

- An apparatus for processing a document service request originating from a mobile computing device in communication with an output device over a first communication channel (column 2, lines 43-47; column 3, lines 3-5). The first

citation shows a mobile computing device (the computer that includes a radio frequency transmitter module). The second citation shows that the mobile device is in communication with output devices.

- A transceiver for responding to a request to establish a second communications channel with the mobile computing device (column 2, lines 45-47). The antenna is the transceiver.
- A document server being adapted to communicate with said transceiver to receive over the second communications channel a document service request originating from the mobile computing device (column 2, lines 43-47). The digital camera is the document server.
- The document service request including a first parameter identifying a document available to the document server and a second parameter identifying a type of output device available over the first communications channel; wherein the document server transmits to the output device via the mobile computing device the document rendered in a format suitable for the output device. (column 3, line 61- column 4, line 6). The cited reference teaches using the mobile computing device to select which pictures are sent to which output device, and how to format the pictures. Passing these two parameters is inherent in this process.

As to claim 3, Parulski et al teaches the document server and the output device have no preexisting communications channel there between (column 2, lines 43-52). The cited reference describes the digital camera (document server) as a separate module from the mobile communications device.

As to claim **7**, Parulski et al teaches the output device is one of a printer, a display, a file server, and a speaker (column 3, lines 3-5).

As to claim **8**, Parulski et al teaches the format suitable for the output device is a device dependent format (column 3, line 61- column 4, line 6).

As to claim **10**, Parulski et al teaches the document service request includes a third parameter identifying one or more document services to apply to the document (column 3, line 61- column 4, line 6). The cited reference teaches using the mobile computing device to select which pictures are sent to which output device, and how to manipulate the document. Passing a parameter that describes what manipulation is needed is inherent in this process.

As to claim **12**, Parulski et al teaches the second communications channel is a wireless communications channel (column 2, lines 45-47). The antenna is a wireless communications channel.

As to claims **13 and 14**, Parulski et al teaches the document server forms part of an input device and the input device is an image-recording device (column 2, lines 43-47).

As to claim **16**, Parulski et al teaches the second communications channel is an unlimited communications channel (column 2, lines 43-47). The RF antenna is an unlimited communications channel.

As to claim **17**, Parulski et al teaches the type of output device available is obtained by executing a discovery request at the mobile computing device (column 3,

lines 61-67). A discovery request must be in order to populate selection menu given to the user.

As to claim **20**, Parulski et al teaches the second parameter identifying the type of output device available over the first communication channel is a class of service (column 3, line 61- column 4, line 6; figure 11). Figure 11 shows that the receivers described by the cited reference can be one of many classes of service.

As to claim **21**, Parulski et al teaches the class of service is wireless printing (column 3, line 61- column 4, line 6; figure 11). Figure 11 shows that the receivers described by the cited reference can be one of many classes of service, including printing. Parulski et al does not limit the classes of service available. Also seen in figure 11, the connection from the mobile computing device (cellular telephone in this case) and the printer is wireless.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims **2, 4-6, 11, 22 and 24** are rejected under 35 U.S.C. 103(a) as being unpatentable over Parulski et al (U.S. 5,666,159) in view of Anderson et al (U.S. 6,493,028).

As to claim 2, Parulski et al teaches all the limitations of claim 1 as described above. Further, Parulski et al teaches transmitting the document from the document server to the output device via the mobile computing device (column 3, line 61- column 4, line 6).

Parulski et al does not teach the document server rendering the document to a format suitable for the output device.

Anderson et al discloses a method and system for extending the available image file formats in an image capture device that teaches using software to manipulate the document in the document server (column 7, lines 18-38), where the digital camera is the document server.

It would have been obvious to one of ordinary skill in the art at the time of invention to incorporate Anderson et al's teachings of manipulating image files within the camera into Parulski et al's device. The motivation would have been to let the document server (camera) handle some of the processing, leaving the mobile computing device more free resources to handle other processes.

As to claim 4, Parulski et al teaches all the limitations of claim 1 as described above.

Parulski et al does not teach the document server prepares the document in a format that conforms to at least one format the output device is adapted to process.

Anderson et al teaches the document server prepares the document in a format that conforms to at least one format the output device is adapted to process. (column 7, lines 18-38).

It would have been obvious to one of ordinary skill in the art at the time of invention to incorporate Anderson et al's teachings of manipulating image files within the camera into Parulski et al's device. The motivation would have been to let the document server (camera) handle some of the processing, leaving the mobile computing device more free resources to handle other processes.

As to claim 5, Parulski et al does not teach the document server applies one of a document enrichment, translation, conversion, summarization, and recommender service to the document before preparing the document in the format suitable for the output device.

Anderson et al teaches the document server applies one of a document enrichment, translation, conversion, summarization, and recommender service to the document before preparing the document in the format suitable for the output device (column 7-8). The cited columns discuss the various services that Anderson's invention can perform on image files. Anderson et al does not limit the services that can be performed by the document server (camera) to documents (image files).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to incorporate Anderson et al's teachings of applying various services to the documents on a document server into Parulski et al's device. The motivation would have been to let the document server (camera) handle some of the processing, leaving the mobile computing device more free resources to handle other processes.

As to claim 6, Parulski et al does not teach the document server communicates with a file server for retrieving the document.

Anderson et al teaches the document server communicates with a file server for retrieving the document (column 7, lines 4-17).

It would have been obvious to one of ordinary skill in the art at the time of invention to incorporate Anderson et al's file server into Parulski et al's device. The motivation would have been to let the document server (camera) handle some of the processing, leaving the mobile computing device more free resources to handle other processes.

As to claim 11, Parulski et al teaches all the limitations of claim 10 as described above. Parulski et al does not teach the third parameter is one of a summarization service, an enrichment service, a recommender service, and a translation service.

Anderson et al teaches that these services can be applied to an image on the document server (columns 7-8). The cited columns discuss the various services that Anderson's invention can perform on image files. Anderson et al does not limit the services that can be performed by the document server (camera) to documents (image files). It is inherent to pass a parameter that describes what services should be applied in order for the document server to know how to proceed.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of invention to incorporate Anderson et al's teachings of applying various services to the documents on a document server into Parulski et al's device. The motivation would have been to let the document server (camera) handle some of the processing, leaving the mobile computing device more free resources to handle other processes.

15. As to claim 24, Parulski et al teaches:

- A storage medium (column 2, lines 43-47). It is inherent that a pen-based computer (e.g. many personal data assistants) system has a storage medium in it.
- Processing a document service request originating from a mobile computing device in communication with an output device over a first communication channel (column 2, lines 43-47; column 3, lines 3-5). The first citation shows a mobile computing device (the computer that includes a radio frequency transmitter module). The second citation shows that the mobile device is in communication with output devices.
- Responding to a request to establish a second communications channel with the mobile computing device (column 2, lines 45-47).
- Receiving over the second communications channel a document service request originating from the mobile computing device (column 2, lines 43-47). The digital camera is the document server.
- The document service request including a first parameter identifying a document available to the document server and a second parameter identifying a type of output device available over the first communications channel; wherein the document server transmits to the output device via the mobile computing device the document rendered in a format suitable for the output device. (column 3, line 61- column 4, line 6). The cited reference teaches using the mobile computing device to select which pictures are sent to which output device, and how to format the pictures. Passing these two parameters is inherent in this process.

Parulski et al does not teach that the document server has a processor.

Anderson et al teaches the document server (camera) has a processor for processing requests (column 7, line 18-26).

It would have been obvious to one of ordinary skill in the art at the time of invention to incorporate Anderson et al's processor, which is built into the camera, into Parulski et al's device. The motivation would have been to let the document server (camera) handle some of the processing, leaving the mobile computing device more free resources to handle other processes.

16. Claim **15** is rejected under 35 U.S.C. 103(a) as being unpatentable over Parulski et al (U.S. 5,666,159) in view of Lamming et al (U.S. 5,862,321).

17. Parulski et al teaches all the limitations of claim 14 as described above. Parulski does not teach that the second communications channel can be a limited communications channel.

18. Lamming et al discloses a system and method for accessing and distributing electronic documents that teaches transferring documents over a limited communications channel (column 5, lines 33-38). The IR channel is the limited communications channel.

19. It would have been obvious to one of ordinary skill in the art at the time of invention to implement the document transfer that Parulski et al teaches over a limited communications channel as described in Lamming et al. The motivation would have

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been faster transfer rates at closer distances. Lamming et al also states that communications over an IR channel may alternatively be implemented using radio channels, showing that they are interchangeable.


Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uttam Kumar whose telephone number is 703-305-0719. The examiner can normally be reached on M-Th 7:30-5; every other Friday 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on 703-308-7562. The fax phone number for the organization where this application or proceeding is assigned is 703-305-3719.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

Uttam Kumar
Art Unit 2157
December 12, 2003


ARIO ETIENNE
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